(D) REMARKS, including DRAWING AMENDMENTS, if any

In Re PARA 1 of the Action

Acknowledged; no response required.

In Re PARA 2 of the Action

Filed herewith again is a copy of EP 1 000 741 A2 per the Examiner's request. Consideration is respectfully requested.

In Re PARA 3, 4 of the Action

The Final Office Action alleged the judicially created doctrine of double patenting in view of applicant/assignee's own U.S. Pat. No. 6,556,470 B1 (Vincent '470 hereinafter). Applicants continue to respectfully and strongly disagree. The arguments previously filed are incorporated herein by reference.

On a technicality, MPEP B.2. also requires: "If the SPE agrees with the examiner than approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made." No approval by the TC Director is evidenced by the Action. Withdrawal is respectfully requested.

Furthermore, in that Action, at Pages16-17, the Examiner counter-argued that MPEP 804 is applicable. Based on the counter-arguments which include indications that novelty and obviousness are not an issue, it is therefor presumed that the Examiner is referring to MPEP 804 B.2. Another Type of Nonstatutory Double Patenting Rejection. This section clearly states that "Non-statutory double patenting rejections based on Schwellen **will be rare**." (Emphasis original.) "The fundamental reason for the rule is to prevent unjustified timewise extension of the right to exclude...has the burden of establishing that the invention claimed in his patent is "independent and distinct"...." The present application was filed October 16, 2001, and the

relied upon Vincent '470 patent was file July 31, 2001 This section goes on to discuss the *In re Kaplan* case where double patenting was *not* upheld even though a broader claim dominated a narrow claim which is also the case here wherein the Examiner is alleging that a "media" claim dominates an "electronic book" claim. Legally speaking, the doctrine is misapplied on these grounds and also therefore should be withdrawn.

Moreover, the direct comparison of independent claims hereinafter highlights some of the patentably independent and distinct features between the present application and Vincent '470:

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PRESENT APPLICATION	VINCENT '470
1. An **electronic book device** comprising: a rewritable viewing **screen**; and an **electrical printhead** for **writing picture elements of said viewing screen**, wherein **said viewing screen has** a rewritable molecular colorant for printing document content therewith.	1. A **colorant** for a substrate, the colorant comprising: **a molecular system**, said system **including electrochromic, switchable molecules**, each of said molecules being selectively switchable between at least **two optically distinguishable states**, wherein each of said molecules exhibit an electric field induced band gap changes via a **molecular conformation change or an isomerization, wherein each of said molecules include at least one stator portion and at least one rotor portion, wherein said rotor rotates from a first state to a second state with an applied electric field, wherein in said first state, there is extended conjugation throughout said molecular system, resulting in a relatively smaller band gap, and wherein in said second state, said extended conjugation is destroyed, resulting in a relatively larger band gap, and wherein** said system is **distributable on the substrate** thereby forming an erasably writable surface.

Similarly, the Vincent '470 independent claims nos. 5 and 7 are for "A colorant...", not for a electronic book or other data display apparatus. Furthermore, it is axiomatic that a dependent claim includes all the limitations of the claim from which it depends and, as such, makes specific

that which was general. 35 U.S.C. 112; 37 C.F.R. Sec. 1.75(c); Allen Group, Inc. V. Nu-Star, Inc., 197 USPQ 849 (7th Cir. 1978); Ex parte Hansen, 99 USPQ 319 (Pat. Off. Bd. App. 1953). Dependent claims are non-obvious if the independent claims from which they depend are non-obvious. In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); *see also* Hartness International, Inc. V. Simplimatic Engineering Co., 2 USPQ2d 1826, 1831 (Fed. Cir. (1987) to the same effect re novelty). Thus, allowance of a base claim as patentable normally results in allowance of a claim dependent upon that claim. Therefore, rejections of the dependent claims should also be withdrawn.

By way of edification for the Patent Office, attached hereto as EXHIBIT 1, "Color Switch Comparison Chart," is a table prepared by K. Vincent as a primer for distinguishing between different types of colorants. It can be clearly seen that each of these mechanisms and modes are technologically highly distinctive. Persons skilled in the art may even consider each of these to be so fundamentally differentiable as to constitute non-analogous art as that term is used in the patenting of inventions. This Exhibit is provided for the convenience of the Office, and is in no way intended as any supplement to the present application nor should any such intention be implied therefrom nor any limitation imposed on the application thereby. The present application, including the Appendix thereto which relates directly to U.S. Pat. Appln. No. 09/844,862, provide the complete antecedent basis for the claim language, including "molecular colorant" or the like. It is again respectfully requested that the rejection should be withdrawn on this ground.

From a purely technical aspect, again as argued before, it is undeniable that an electronic book is a patentably distinct invention from the elements which form a display for an electronic book. To allege obviousness of a complex portable apparatus from the colorant used to form images on it still seems to the inventors herein to be technologically equivalent to alleging paper is obvious from the knowledge of ink.

The Examiner in para. 3 of the Actions cites several legal decisions. It is applicants opinion that these very decisions speak against using nonstatutory double patenting in the present situation, particularly since the same inventors are involved. The judicially created doctrine of

obviousness-type double patenting is to prevent the extension of the term of a patent where an express statutory basis for a rejection is missing, by prohibiting the issuance of claims in a second patent *that are not patentably distinct.* In re Longi, 225 USPQ 645 (Fed. Cir. 1985)(emphasis added). Here the claims show distinct patentable elements. The Office, at page 2 of the Action, admits that "...the conflicting claims are not identical...". In fact, as shown above, the claims are to two vastly different technologies even though one incorporates elements of the other. Reasoning to the contrary would lead to the situation that a manufacturer could never patent any apparatus if it patented a sub-element thereof first. For example, once filing for a patentable semiconductor transistor element, all integrated circuits using that element would be non-patentable. This is not the intent of these cases nor the doctrine.

It is respectfully requested that the rejection be withdrawn.

In Re Rejections Under 103, Action Para. 5 - 10

There is no showing in the cited art of a "molecular colorant" as that term is used in the present application, including each independent claim. It is axiomatic that claims are not to be interpreted in a vacuum. Slimfold Mfg. Col v. Kinkead Indus.,810 f.2d 1113, 1 USPQ 2d 1563 (Fed. Cir. 1987); Moleculon Res. Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986). The claim and specification language must be considered. DMI, Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed. Cir. 1985). By ignoring the present application's use of the claims limitations as discussed in the Detailed Description, the argument as set forth in the Action ignores this requirement. Understanding, or Interpreting, a limitation *already in a claim* in light of the Detailed Description is not the same as an impermissible reading of a limitation into a claim. Otherwise, these court decisions are rendered meaningless.

It is respectfully requested that the rejections be withdrawn.

In Re Action Para. 11

See arguments hereinabove and in prior responses to prior Office Actions.

In Re Action Para. 12

No response required.

Based upon the foregoing, it is submitted that the application now presents claims which are directed to novel, unobvious and distinct features of the present invention which are an advancement to the state of the art. Reconsideration and early allowance of all claims is respectfully requested. The right is expressly reserved to reassert any and all arguments, including the raising of new arguments, should a Notice of Allowance not be forthcoming.

Questions or suggestions that will advance the case to allowance may be directed to the undersigned by teleconference at the Examiner's convenience.

Date: MAY 25, 2004

Respectfully submitted,
Hewlett-Packard Company

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